

REMARKS/ARGUMENTS

Reconsideration of the above-identified application in view of the present amendment is respectfully requested. By this amendment, claims 9 and 11 are amended. Claim 11 is amended to overcome the objection to claim 11 and does not raise new issues that would require further consideration and/or search.

Claim 9 is amended to include all of the limitations of the base claim and intervening claims. Therefore, claim 9 is allowable, as indicated in the Office Action.

Claims 1 and 15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,942,246 to Hohne et al. ("Hohne") in view of U.S. Patent No. 6,550,804 to Burdock ("Burdock"). Withdrawal of this rejection is respectfully requested for at least the following reasons.

The M.P.E.P. sets forth the criteria for a rejection for obviousness under 35 U.S.C. §103 as follows:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

See, M.P.E.P. § 706.02(j) *citing In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

1. There is no reasonable expectation of success in combining Hohne and Burdock to achieve the gas bag restraint device recited in claim 1.

There is no reasonable expectation of success in combining Hohne and Burdock to meet the limitations of claim 1. Claim 1 recites a covering cap with a central section delimited by a ring-shaped tear line and including a mounting opening for a separate plaque piece. The plaque piece fastens the central section of the covering cap and prevents the central section from moving freely when the covering cap opens. The central section can be placed onto the plaque piece from above such that an inner edge of the central section snaps in place underneath a laterally projecting edge of the plaque piece.

If the structure of Burdock and Hohne is combined as suggested in the Office Action, the central section is incapable of being placed onto the plaque piece from above.

The Office Action relies on Burdock as disclosing a fascia panel that prevents a central section of a cover from moving freely when the cover opens. In Burdock, the cover extends across the entire air bag module. The fascia panel overlies the central portion of the cover and is fastened to the control module. The central portion is thus positioned between the control module and the fascia panel. Due to this structure, the cover in Burdock clearly is not capable of being placed onto the fascia panel from above as recited in claim 1. In Burdock, the fascia panel must be secured to the control module after the cover is positioned on the air bag module.

For these reasons, the rejection of claim 1 under 35 U.S.C. §103(a) as being obvious over Hohne in view of Burdock is improper and should be withdrawn.

2. There is no suggestion or motivation Hohne, Burdock, or in the level of ordinary skill in the art to combine their respective teachings.

There is no suggestion or motivation in Hohne or Burdock, or in the knowledge of one of ordinary skill in the art, to combine the teachings of Hohne and Burdock as proposed in the rejection of claims 1 and 15. The Office Action states that it would be obvious to incorporate the teaching of Burdock into Hohne in order to facilitate opening and prevent fragmentation. This reasoning is flawed.

In Hohne, the central portion of the cover is not separated from radially outward portions of the cover upon deployment of the air bag. Therefore, in Hohne, there is no risk of fragmentation between separated portions of the cover. The motivation to combine Hohne with Burdock in order to prevent fragmentation is therefore lacking.

For these reasons, the rejection of claims 1 and 15 under 35 U.S.C. §103(a) as being obvious over Hohne in view of Burdock is improper and should be withdrawn.

3. Hohne teaches away from the present invention.

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). It is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

The Office Action states that Hohne teaches that tear or yield lines can be used. In context, however, this teaching is restricted to describing how some particular plastic materials can be used to form the cover. This passage does not provide any teaching or suggestion whatsoever related to the desirability of using a

tear line to delineate a central section of the cover. In fact, the passage explicitly teaches that tear seams disadvantageously result in visible lines on the outer surface of the cover. Therefore, Hohne teaches the desirability of avoiding the use of tear seams.

For these reasons, the rejection of claims 1 and 15 under 35 U.S.C. §103(a) as being obvious over Hohne in view of Burdock is improper and should be withdrawn.

4. The motivation to combine of Hohne and Burdock is derived from hindsight.

It is respectfully suggested that the rejection of claims 1 and 15 under 35 U.S.C. §103(a) as being obvious over Hohne in view of Burdock only seems plausible using hindsight after having the benefit of the Applicants' disclosure. The use of the teachings of the present invention to find obviousness is impermissible.

The court must be ever alert not to read obviousness into an invention on the basis of applicant's own statements; that is, we must view the prior art without reading into that art applicant's teachings. The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention as a whole obvious.

In Re Spinnoble, 160 USPQ 237 at 243 (CCPA 1969) (emphasis in original).

Accordingly, the Examiner must consider only the teachings of the prior art references.

As set forth above, in Hohne, the problem of fragmentation between a central portion of the cover and radially outward portions of the cover upon deployment of the air bag is non-existent and, therefore, there is no motivation to combine Hohne with Burdock. Therefore, it is readily apparent that, without the teachings of the

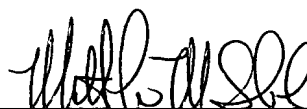
present invention, one of ordinary skill in the art would not even consider combining the teachings of Hohne and Burdock.

For these reasons, the rejection of claims 1 and 15 under 35 U.S.C. §103(a) as being obvious over Hohne in view of Burdock is improper and should be withdrawn.

For the reasons set forth above, it is respectfully submitted that claims 1 and 15 are allowable. Claims 2, 3, 5, 7, and 10-14 depend from claim 1 and are allowable as depending from an allowable claim and also for the specific limitations recited therein. Claims 16-18 depend from claim 15 and are allowable as depending from an allowable claim and also for the specific limitations recited therein.

In view of the foregoing, it is respectfully submitted that the above-identified patent application is in condition for allowance, and allowance of the above-identified patent application is respectfully requested. Please charge any deficiency or credit any overpayment in the fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,



Matthew M. Shaheen
Reg. No. 45,367

TAROLLI, SUNDHEIM, COVELL,
& TUMMINO L.L.P.
1300 East Ninth Street, Suite 1700
Cleveland, Ohio 44114
Phone: (216) 621-2234
Fax: (216) 621-4072
Customer No.: 26,294